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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,738	01/09/2002	Wolfgang Brauer	Mo-6931/LeA 35,798	6549
157	7590	05/03/2004	EXAMINER	
BAYER POLYMERS LLC			SERGENT, RABON A	
100 BAYER ROAD			ART UNIT	
PITTSBURGH, PA 15205			PAPER NUMBER	
			1711	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Advisory Action	Application No. 10/043,738	Applicant(s) BRAUER ET AL.	
	Examiner Rabon Sergeant	Art Unit 1711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 5 and 7-11.


Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Rabon Sergeant
Primary Examiner
Art Unit: 1711

Continuation of 3.: The rejection of claims 5 and 7-11 under 35 USC 112, first paragraph, set forth within paragraph 1 of the final Office action.

Continuation of 5.: Applicants' response has been considered; however, the prior art rejection has been maintained for the reasons set forth within the final Office action. Furthermore, applicants' argument that Shah teaches away from the use of prepolymers is not well taken. Shah clearly teaches a prepolymer method, and though it is less preferred, it cannot be said that the reference teaches away from the prepolymer method. In order for the reference to teach away from the instant invention, the reference must provide disclosure that precludes the methods or characteristics of the instant claims. Clearly, this is not the case, since Shah provides clear and enabling disclosure for the prepolymer method. One cannot equate a less preferred, though fully disclosed and operable, embodiment with a "taught away from" mode of operation or embodiment. Applicants' argument that the "consisting of" language excludes intervening steps between formation of the prepolymer and formation of the elastomer and, as a result, removes the Muller et al. reference has been considered. However, the argument is deficient for the following reasons. Applicants' first step simply requires the formation of the prepolymer within a tubular reactor or static mixer, and it can be argued that the process sequence of Muller et al. (A through C or D) simply sets forth the formation of the prepolymer within tubular reactors or static mixers. Additionally or alternatively, applicants' argument in no way addresses the obviousness of applicants' process in view of Muller et al. Steps A, B, E, and F of Muller et al. are clearly encompassed by applicants' claims and one of ordinary skill would have realized that steps C and D can be minimized or even excluded, depending on controllable process variables or conditions.


RABON SERGENT
PRIMARY EXAMINER